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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/463,096 04/12/00 TANDLER

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MMC2/1109

H	GK-751-0070
EXAMINER	

ART.UNITED	PAPER NUMBER
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DATE MAILED:

11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/463,096

Applicant(s)

TANDLER ET AL.

Examiner

Jennifer E Winstedt

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

✓ Claim 16 recites the limitation "the lens members" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

✓ Claim 19 recites the limitation "the lens pairs" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

✓ Claim 22 recites the limitation "the linear magnification" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

✓ Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the phrase "can be" in line 2 is indefinite. It is uncertain whether or not the limitations following this phrase are part of the claimed combination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 13-21 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Biber et al. (U.S. Patent 5,825,535).

Regarding claim 13, Biber et al. discloses an arrangement for directly controlling the movement of a zoom system in a stereo microscope comprising direct driving motors for at least one moving lens system (8, 9, Figures 1 and 2 and column 3, line 66 – column 4, line 12).

Regarding claim 14, Biber et al. discloses that two lens members are controlled independently from one another (column 4, lines 6-9).

Regarding claim 15, Biber et al. discloses that the lens members are provided as lens pairs in a Greenough type stereo microscope or a telescope type stereo microscope (column 1, lines 54-55; a telescope type stereo microscope).

Regarding claim 16, Biber et al. discloses that the drives are controlled by a control unit (10, Figure 1) which reads out the pre-stored values for the movement of the lens members and controls the drives in a corresponding manner (column 4, lines 52-61).

Regarding claim 17, Biber et al. discloses that the drives are linear drives (column 4, lines 60-61; stepping motors are well known to be linear drives).

Regarding claim 18, Biber et al. discloses that the linear drives are arranged in the stereo microscope housing (8, 9, 1, Figures 1 and 2).

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Regarding claim 19, Biber et al. discloses that the drives are arranged between lens pairs (drive 8, which moves lens member 3, is arranged between lens member 5 and lens member 3 (the first lens pair) and drive 9, which moves lens member 4, is arranged between lens member 5 and lens member 4 (the second lens pair); see Figures 1 and 2).

Regarding claim 20, Biber et al. discloses that a plurality of moving lens members are controlled jointly (column 4, lines 6-9; when the individual optical elements are displaced along the optical axis at the simultaneously, the optical elements are being controlled jointly).

Regarding claim 21, Biber et al. discloses that at least two lens members are driven separately (column 4, lines 6-9).

Regarding claim 24, Biber et al. discloses a method for adjusting zoom systems in an arrangement for directly controlling the movement of a zoom system in a stereo microscope having direct driving motors for at least one moving lens system wherein drives (8, 9, Figures 1 and 2) are provided for driving at least two lens members (3, 4, Figure 1) separately (column 4, lines 6-9).

Claims 13 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Pensel et al. (U.S. Patent 5,867,308).

Regarding claim 13, Pensel et al. discloses an arrangement for directly controlling the movement of a zoom system in a stereo microscopic, comprising direct driving motors for at least one moving lens system (15, 16, Figure 3).

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Regarding claim 22, Pensel et al. discloses that the linear magnification that is adjusted is determined and displayed to the operator during the controlling of the zoom system (12, Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biber et al.

Regarding claim 23, Biber et al. discloses a control unit used for motorized zoom adjustment and for motorized focusing of the microscope (10, Figure 1 and column 4, lines 10-20 and 35-39). Biber et al. does not disclose more than one control unit. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have more than one control unit, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E Winstedt whose telephone number is (703) 305-0577. The examiner can normally be reached on 7:30 - 17:00 Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Casandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JW
November 1, 2001

A handwritten signature in black ink, appearing to read 'Audrey Chang', with a large, sweeping initial 'A' and a stylized 'C'.

Audrey Chang
Primary Examiner
Technology Center 2800